REMARKS

Claims 1-3, 5-8, 10-15, 17-21 and 23-27 are pending in the present application. Claims 1, 6, 11, 12, 13, 19 and 25-27 are independent and have been amended.

112 REJECTION

Claims 1, 6, 11-13, 19 and 25-27 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Each of claims 1, 6, 11-13, 19 and 25-27 have been amended to recite "the name of an apparatus and/or service provider," which is supported in the Specification on page 5, line 8 and page 12, lines 1-3.

ART REJECTIONS

Moghadam et al., Cameron et al., Cloutier et al. and PC Magazine Online

Claims 1-3, 5-8, 10, 13-15 and 17-21, and 23-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Moghadam et al. (U.S. Patent No. 5,799,219) in view of Cameron et al. (U.S. Patent No. 5,592,378), Cloutier et al. (U.S. Patent No. 5,229,810) and PC Magazine Online ("Photo Finishing on the Web"). Applicants respectfully traverse this rejection.

In Applicants' prior response of September 11, 2000, Applicants argued that the Examiner has failed to establish motivation why one of ordinary skill in the art would combine Moghadam et al, Cameron et al., Cloutier and PC Magazine Online. Applicants maintain this argument.

However, even assuming *arguendo* that the examiner has established proper motivation to combine the references, Moghadam et al, Cameron et al., Cloutier and PC Magazine Online, either alone or in combination do not disclose all the features of independent claims 1, 6, 13, 19 and 25-27.

In particular claim 1 and similarly claims 6, 13, 19 and 25-27, as amended recite, "wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium."

The Examiner relies on Moghadam as disclosing displaying the printing service information and generating the print ordering information by using the displayed printing service information. See Office Action dated November 6, 2000 page 6, lines 8-14. However, Moghadam's teaching regarding the display of print service information is limited to the size of the image. See Moghadam col. 6, lines 3-8. Moghadam does not display print information including the kind of attributes such as extra print generation, postcard generation, calendar generation, finish of the print, and kinds of illustrations and characters that can be combined with the image. Further, Moghadam merely teaches using

three fields to allow the user to select the picture size and therefore could not satisfy the plurality of print service attributes as claimed.

Cameron arguably teaches a computerized order entry system which allows user to order from catalogs items such as TVs and clothing. Also, Cameron allows a user to select the attributes of the items they ordering. However, Cameron discloses nothing with respect to the attributes for print services for a print of a picture image.

Further, in Cameron the targeted picture service is carried out on the user side and requires the relation of the order with the image data. This is different from Applicants' invention, which chooses among the variety of services offered for the images.

Cloutier et al. arguably teaches a film information exchange system including magnetic tracks on which data is recorded. Cloutier does not teach recording a "plurality of print attributes" but rather a retail order station which merely records a plurality of print instructions as discussed in column 9, lines 7-35. Further, Cloutier does not teach recording the name of the name of the apparatus of service provider that has recorded the print instructions.

"Photo Finish on the Web" merely discusses photo processing generally and teaches nothing with respect to recording print service attributes on a recording medium.

Accordingly claims 1, 6, 13, 19 and 25-27, are allowable over the prior art. Regarding dependent claims 2, 3, 5, 7, 8, 10, 14, 15, 17-21, 23 and 24,

these claims are allowable for at least the reasons of their corresponding independent claims. Thus, Applicants respectfully request removal of this rejection.

Moghadam et al., PC Magazine Online and Cloutier et al.

Claims 11 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Moghadam et al. in view of PC Magazine Online and Cloutier et al. Applicants respectfully traverse these rejections.

In Applicants' prior response of September 11, 2000, Applicants argued that the Examiner has failed to establish motivation why one of ordinary skill in the art would combine Moghadam et al., Cloutier and PC Magazine Online. Applicants maintain this argument.

Further, even assuming *arguendo* that the examiner has established proper motivation to combine the references, Moghadam et al., Cloutier and PC Magazine Online, either alone or in combination do not disclose all the features of independent claims 11 and 12.

Similar to claims 1, 6, 13, 19 and 25-27, claims 11 and 12 as amended recite, "wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium."

For the reasons described above, claims 11 and 12 are allowable over the prior art. Thus, Applicants respectfully request removal of these rejections.

ENTRY OF AMENDMENT REQUESTED

Applicants respectfully request entry of this Amendment in that it raises no new issues requiring further consideration and/or search. The only amendments made to the claims alleviate the rejection under 35 U.S.C. § 112 in the manner requested by the Examiner. In the alternative, the Amendment should be entered in that it places the claims in better form for appeal by removing the Section 112 rejection and thus reducing the issues for appeal.

CONCLUSION

In view of the above amendments and remarks, reconsideration of the various rejections and allowance of claims 1-3, 5-8, 10-15, 17-21 and 23-27 of the present application is respectfully requested.

In the event that there are any pending matters remaining in the present application, the Examiner is invited to contact John A. Castellano at (703) 205-8000 in the Washington, D.C. area, to discuss this application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Pursuant to 37 C.F.R. 1.17 and 1.136(a), the Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application, and the required fee of $110.00 is attached.
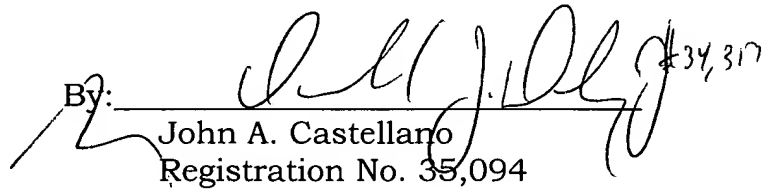
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH STEWART KOLASCH & BIRCH LLP

By: _____
John A. Castellano
Registration No. 35,094

JAC/JES:ewd

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Please amend the following claims:

1. (Thrice Amended) A picture print ordering method which orders a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system, comprising the steps of:

recording high resolution picture image data obtained by reading a developed film and printing service information regarding the printing service which can be provided for the high resolution picture image data in a predetermined recording medium;

displaying the printing service information and the image data recorded in the recording medium when the print ordering information for requesting a printing service regarding the image data recorded in the recording medium is generated; and

generating the print ordering information by using the displayed printing service information;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium.

15

6. (Thrice Amended)   A picture print ordering system which orders a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system, comprising;

printing service information recording means which records high resolution picture image data obtained by reading a developed film and printing service information regarding the printing services which can be provided to the high resolution picture image data in a predetermined recording medium;

display means which displays the printing service information recorded in the recording medium and the image data when the print ordering information for requesting a printing service regarding the image data recorded in the recording medium is generated;

input receiving means which receives input of a variety of instruction information using the displayed printing service information; and

print ordering information generating means which generates the print ordering information by using the displayed printing service information received by the input receiving means;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium.

11. (Twice Amended)

A photo finishing system comprising image data obtaining means which obtains high resolution picture image data, print ordering information obtaining means which obtains print ordering information regarding the high resolution picture image data, and print generating means which carries out a variety of printing processing based on the print ordering information, wherein

the print ordering information obtaining means obtains print ordering information have been generated by using printing service information and the high resolution picture image data displayed on a predetermined order screen as print services which can be provided for the high resolution picture image data, and

the print generating means carries out a variety of printing processing for providing the printing service displayed as the printing service information, based on the print ordering information;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been displayed on the order screen.

12. (Thrice Amended) A recording medium wherein a program is stored by means of which a computer generates print ordering information in order to order a print of a picture image, said print ordering information comprising

17

electronic data in a predetermined standard to be processed by a predetermined photo finishing system, the program comprising the steps of:

displaying printing service information and high resolution picture image data of the picture image recorded in a predetermined recording medium on a display apparatus connected to the computer;

enabling instruction information using the displayed printing service information to be inputed by a variety of input devices of the computer; and

generating the print ordering information based on the instruction information input by the variety of input devices;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium.

13. (Twice Amended) A picture print ordering method comprising the steps of:

recording high resolution picture image data, obtained by reading a developed film, and printing service information regarding printing services, which can be provided for the high resolution picture image data, on a recording medium by a photo finishing system;

displaying the printing service information and the high resolution picture image data from the recording medium at a user device,

18

generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium.

19. (Twice Amended) A picture print ordering system comprising:

a first recording unit for recording high resolution picture image data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the high resolution picture image data on a recording medium by a photo finishing system;

a display unit for displaying the printing service information and the high resolution picture image data from the recording medium at a user device; and

a generating unit for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been displayed.

19

25. (Twice Amended) A photo finishing system comprising:

an image data obtaining unit which obtains high resolution picture image data from a user;

a print ordering information obtaining unit which obtains print ordering information regarding the high resolution picture image data from the user; and

a print generating unit which carries out a variety of printing processes based on the print ordering information, wherein the print ordering information is generated using printing service information and the high resolution picture image data displayed on a user device;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium.

26. (Twice Amended) A computer program embodied on a computer-readable medium for ordering prints comprising:

a recording source code segment for recording full image picture data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the high resolution picture image data on a recording medium by a photo finishing system;

a displaying source code segment for displaying the printing service information and the high resolution picture image data from the recording medium at a user device; and

a generating source code segment for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information;

wherein the printing service information includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium.

27. (Twice Amended) A medium comprising:

a first recording area for recording picture image data with high resolution; and

a second recording area for recording information regarding printing services, wherein the picture image data with high resolution and the information regarding printing services are provided together to a customer;
the customer ordering a print out according to the information regarding printing services and the picture image data with high resolution;

wherein the information regarding printing services includes <u>a plurality of attributes including size and kind and the name of</u> [information showing] an

21

apparatus and/or a service provider by which the printing service information

has been produced.